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Peter R. Brownell

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801 GRAND AVENUE  
SUITE 3200  
DES MOINES, IA 50309-2721

EXAMINER

FRENEL, VANEL

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* PETER R. BROWNELL  
9

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11 Appeal 2007-2931  
12 Application 10/752,879  
13 Technology Center 3600  
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16 Decided: April 18, 2008  
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18  
19 Before TERRY J. OWENS, HUBERT C. LORIN, and  
20 ANTON W. FETTING, *Administrative Patent Judges*.  
21 FETTING, *Administrative Patent Judge*.

22  
23 DECISION ON APPEAL

24 STATEMENT OF CASE

25 Peter R. Brownell (Appellant) seeks review under 35 U.S.C. § 134 of  
26 a final rejection of claims 1-21, the only claims pending in the application on  
27 appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
2 (2002).

3 We REVERSE.

4 The Appellant invented a way for on-line ordering of component  
5 parts, and in particular to the on-line ordering of component parts for guns  
6 from a supplier (Specification 1:5-6). It provides for selling replacement  
7 parts for products over a computer network. A customer can identify and  
8 order replacement parts for a product such as a gun or other firearm product.  
9 The on-line ordering provides product manufacturer selection options for  
10 customers to select from and part selections for the customer to select from.  
11 It also provides an interactive schematic illustrating component parts of the  
12 product with associated reference identifiers for selecting the component  
13 parts. It also provides descriptions of component parts selected, including a  
14 name and part number for the component part (Specification 2:12-23).

15 An understanding of the invention can be derived from a reading of  
16 exemplary claim 1, which is reproduced below [bracketed matter and some  
17 paragraphing added].

18 1. A method of selling replacement parts for a product to a  
19 customer and over a computer network, comprising:

20 [1] providing a plurality of product manufacturer selection  
21 options for the customer to select from over the computer  
22 network;

23 [2] receiving a manufacturer selection of one of the product  
24 manufacturers from the customer and over the computer  
25 network;

26 [3] providing a plurality of product selections for the customer  
27 to select from over the computer network;

1 [4] receiving a product selection of one of the products from the  
2 customer and over the computer network;

3 [5] providing over the computer network and to the customer an  
4 interactive schematic

5 illustrating a plurality of component parts of the product  
6 with associated reference identifiers;

7 [6] receiving a selection from the interactive schematic of at  
8 least one of the component parts over the computer network.

9

10 This appeal arises from the Examiner's Final Rejection, mailed  
11 February 14, 2006. The Appellant filed an Appeal Brief in support of the  
12 appeal on September 12, 2006. An Examiner's Answer to the Appeal Brief  
13 was mailed on December 7, 2006. A Reply Brief was filed on February 7,  
14 2007.

15 PRIOR ART

16 The Examiner relies upon the following prior art: Uemura  
17 US 2001/0027429 A1 Oct. 4, 2001

18 REJECTION

19 Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable  
20 over Uemura.

21 ISSUES

22 The issue pertinent to this appeal is whether the Appellant has  
23 sustained its burden of showing that the Examiner erred in rejecting claims  
24 1-21 under 35 U.S.C. § 103(a) as unpatentable over Uemura. The pertinent

1 issue turns on whether it would have been obvious to add steps [1] to [4] to  
2 Uemura.

3                                   FACTS PERTINENT TO THE ISSUES

4           The following enumerated Findings of Fact (FF) are believed to be  
5 supported by a preponderance of the evidence.

6           *Uemura*

7           01. Uemura is directed to a system for ordering parts of an  
8 analyzing system. Uemura's system stores part numbers data of  
9 the analyzing system and is capable of ordering a part  
10 corresponding to a part number by transmitting the part number to  
11 a supplier (Uemura: ¶ 0012).

12          02. Uemura's analyzer has a computer as part of it (Uemura: ¶  
13 0032; Fig. 1). This computer stores an equipment managing  
14 program for that analyzer, which includes a database of parts used  
15 by the analyzer, including part numbers (Uemura: ¶ 0041; Fig. 4).

16          03. Uemura also describes an interactive schematic, which Uemura  
17 refers to as a specifying diagram (Uemura: ¶ 0042; Fig. 5).  
18 Uemura does not explicitly describe where this schematic is  
19 stored, but implies it is stored in the same location as the parts  
20 data.

21          04. Uemura's parts suppliers provide a user identification number  
22 unique to each analyzer (Uemura: ¶ 0038).

23           *Facts Related To Differences Between The Claimed Subject Matter And*  
24 *The Prior Art*

05. Uemura does not describe or suggest steps [1]-[4] of claim 1.

### *Facts Related To The Level Of Skill In The Art*

06. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent art of online ordering. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

### *Facts Related To Secondary Considerations*

07. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

# PRINCIPLES OF LAW

### Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the

1 specification” without importing limitations from the specification into the  
2 claims unnecessarily).

3         Although a patent applicant is entitled to be his or her own  
4 lexicographer of patent claim terms, in *ex parte* prosecution it must be  
5 within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant  
6 must do so by placing such definitions in the specification with sufficient  
7 clarity to provide a person of ordinary skill in the art with clear and precise  
8 notice of the meaning that is to be construed. *See also In re Paulsen*, 30  
9 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the  
10 specific terms used to describe the invention, this must be done with  
11 reasonable clarity, deliberateness, and precision; where an inventor chooses  
12 to give terms uncommon meanings, the inventor must set out any  
13 uncommon definition in some manner within the patent disclosure so as to  
14 give one of ordinary skill in the art notice of the change).

15 *Obviousness*

16         A claimed invention is unpatentable if the differences between it and  
17 the prior art are “such that the subject matter as a whole would have been  
18 obvious at the time the invention was made to a person having ordinary skill  
19 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct.  
20 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14  
21 (1966).

22         In *Graham*, the Court held that that the obviousness analysis is  
23 bottomed on several basic factual inquiries: “[1] the scope and content of  
24 the prior art are to be determined; [(2)] differences between the prior art and  
25 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill  
26 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*

1 *Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to  
2 known methods is likely to be obvious when it does no more than yield  
3 predictable results.” *KSR*, at 1739.

4 “When a work is available in one field of endeavor, design incentives  
5 and other market forces can prompt variations of it, either in the same field  
6 or in a different one. If a person of ordinary skill in the art can implement a  
7 predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

8 “For the same reason, if a technique has been used to improve one  
9 device, and a person of ordinary skill in the art would recognize that it would  
10 improve similar devices in the same way, using the technique is obvious  
11 unless its actual application is beyond his or her skill.” *Id.*

12 “Under the correct analysis, any need or problem known in the field  
13 of endeavor at the time of invention and addressed by the patent can provide  
14 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

#### 15 ANALYSIS

16 *Claims 1-21 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
17 *Uemura.*

18 The Examiner found that Uemura described steps [5] and [6] of claim  
19 1. The Examiner further found that one of ordinary skill would have known  
20 that steps [1]-[4] would have allowed a customer to order parts for more than  
21 one product. The Examiner concluded that it would have been obvious to a  
22 person of ordinary skill in the art to have added steps [1] to [4] to Uemura  
23 since it is well settled that it is obvious that mere duplication of essential



1 working parts involves only routine skill, citing *In re Harza*, 274 F.2d 669  
2 (CCPA 1960) (Answer 4).

3 The Appellant contends that adding multiple manufacturers is not  
4 mere duplication of parts (Br. 5:¶ 2) and that Uemura's schematic is not  
5 provided over a network (Br. 4:¶ 1).

6 We agree. This is not a case as in *Harza* of duplicating a component  
7 found in the art, as with plural ribs for stopping water from a reference  
8 describing a single rib in *Harza, id* at 672. This is a case where the  
9 limitation proposed by the Examiner is neither in the art nor suggested by or  
10 even desirable with respect to the particular art applied (FF 05).

11 As the Appellant argues, Uemura simply has no need for  
12 manufacturer and product selections, for the simple reason that Uemura's  
13 product ordering system is designed for a single product whose  
14 manufacturer and product are already established as the environment within  
15 which Uemura's system operates. While the simple question "who am I"  
16 makes for interesting philosophical inquiries, there is no reason that  
17 Uemura's system would ever ask such a question, which would be the only  
18 reason for adding steps [1]-[4] to what is described by Uemura. There is not  
19 even a need for determining the manufacturer and model when ordering  
20 parts because every analyzer is uniquely pre-identified by a user identifier  
21 that is used to communicate with suppliers (FF 04).

22 Uemura is directed to an analyzer that includes a system for ordering  
23 parts used by that analyzer (FF 01 & 02). The exact list of parts with part  
24 numbers needed for Uemura's analyzer is stored within Uemura's analyzer,  
25 itself. Thus, when ordering parts in Uemura, there is no need to first

1 determine a manufacturer and product to find a parts list or an interactive  
2 schematic, as in steps [1]-[4]. Uemura implies that its interactive schematic  
3 is internally stored, along with the parts data (FF 03). Thus, there would be  
4 no need for supplying the schematic from a network as in claim 1. Thus, the  
5 Examiner has chosen to apply a reference which clearly and particularly  
6 negates the need for the modifications proposed by the Examiner. For this  
7 reason, we must conclude the Examiner has failed to make a prima facie  
8 showing of obviousness.

9       The remaining independent claims contain steps similar to steps [1]-  
10 [4] in claim 1, and the dependent claims contain these steps by virtue of  
11 incorporating the subject matter of the independent claims. Since these  
12 issues are dispositive for all claims, the remaining arguments by the  
13 Appellant are moot.

14       The Appellant has sustained its burden of showing that the Examiner  
15 erred in rejecting claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over  
16 Uemura.

#### 17 CONCLUSIONS OF LAW

18       The Appellant has sustained its burden of showing that the Examiner  
19 erred in rejecting claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over  
20 the prior art.

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DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over Uemura is not sustained.

REVERSED

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